

Practitioner's Docket No. MPI00-010P1RCP1RCEM

U.S.S.N. 10/658,904

REMARKS

This Amendment and Response is in reply to the Office communication mailed December 20, 2006. Applicant thanks the Examiner for entering the response filed on October 13, 2006, for rejoining claims 12-13, 23-28 and 35, and for withdrawing some rejections. In this Amendment and Response, claims 5 and 15 are being amended. No new matter is being added. Claims 5, 6, 12, 13, 15, 16, 21 and 23-35 are pending (claims 30-34 are withdrawn).

Drawings

In the next communication, Applicant respectfully requests that the Examiner indicate whether the drawings filed on September 10, 2003 are acceptable.

Interview Summary

Applicant thanks the Examiner for the helpful telephone interviews. On February 5, 2007, the Examiner clarified that the Office Action is Non-Final, contrary to the statement on page 5. Also the Examiner acknowledged that the rejection on page 5 pertained only to claim 21, and not to claim 35. On March 1, 2007, the Examiner clarified the rejection to claims 5 and 15. A consensus was reached.

Pages 3-5. Rejections of the Claims Under 35 U.S.C. §112, Second Paragraph

The claims were rejected under 35 U.S.C. §112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each rejection is treated separately in the following remarks.

Claims 5-6, 12-13 and 23-26. Claims 5-6, 12-13 and 23-26 were rejected under 35 U.S.C. §112, second paragraph for the recitation of "a kinase activity" in claim 5. As revealed in the interview on March 1, 2007, the Examiner interpreted this term as broadening the scope of activity of the 14171 kinase beyond what a serine/threonine kinase would do. In particular, the concern was that the term would extend to, e.g., tyrosine kinases, which is not supported in the specification. Applicant herein clarifies that this was not the intent of the term, rather to indicate activity discovered for this 14171 serine/threonine kinase as supported by the present specification. Since the recitation of "a" caused this misinterpretation, that term is being removed from claim 5. In view of the amendments to claim 5, Applicant believes that this rejection to claim 5 (claims 6, 12-13 and 23-26 dependent thereon) is obviated. Withdrawal of this rejection is respectfully requested.

Claims 15-16 and 27-28. Claims 15-16 and 27-28 were rejected under 35 U.S.C. §112, second paragraph for reciting "an activity of the polypeptide." This rejection seems to stem from a similar

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misunderstanding as what led to the rejection of claim 5. While Applicant is amending claim 15 (claims 16, 27 and 28 dependent thereon) to replace the term "an" with "the" in order to advance the application, Applicant is not acquiescing to the arguments put forth on pages 4-5 of the Office Action. Applicant notes, that while the activities presented as 14171 kinase activities may be shared with kinases of the prior art, the prior art does not have the sequences recited in claim 5, on which claim 15 depends. Therefore, it should be valid to define the 14171 kinase as having multiple activities, especially when multiple activities were actually reduced to practice in examples as are provided in the present specification. (Note that control studies described in the examples led Applicant away from reciting other potential activities for the 14171 kinase.) And the contention that NF-kB activation is not well-defined in the prior art ignores the results of extensive research published prior to February 2000 describing NF-kB function, activation and biological consequences thereof (a search of PubMed (on the website maintained by the National Center for Biotechnology Information, Bethesda, MD) for "NF-kB" and "activation" on 3/2/07 retrieves more than 3000 records published by February 2000). While NF-kB activation certainly is complex, it clearly was substantially defined by the time of filing the present application and one of skill in the art would have known that this term referred to several activities, including apoptosis, cell signaling, and cytokine activities. However, as these pathway activities likely stem initially from basic serine/threonine kinase activity of 14171, Applicant is amenable, for the purpose of claim definition, to recite the kinase activity. In view of the amendment to claim 15 (claims 16, 27 and 28 dependent thereon), Applicant respectfully requests withdrawal of this rejection.

#### Allowable Subject Matter

On page 5, the Examiner indicated that claims 21 and 35 would be allowable if made independent. Since claim 35 already was independent, the Examiner acknowledged in the February 5, 2007 interview, that this rejection does not pertain to claim 35. Applicant respectfully requests confirmation that claim 35 is allowed. In regard to claim 21, Applicant believes that the amendments to claim 5, on which claim 21 depends, render claim 5 allowable. Therefore, no amendment to claim 21 should be necessary. Applicant would be happy to work with the Examiner on this claim if a further issue arises at a later date.

#### Rejoinder

Applicant submits that claims 5, 6, 12, 13, 15, 16, 21, 23-28 and 35 are allowable with respect to the group elected after the Restriction Requirement of August 1, 2005. Applicant respectfully requests that the Examiner reconsider rejoinder of withdrawn claims 29-34 under MPEP § 821.04. Withdrawn claims 29-34 do depend from or otherwise include all the limitations of the allowable product claims, but just have additional steps which take place in a cell. Applicant submits that such additional steps should

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not require serious burden for the Examiner to review. In the next Office communication, Applicant respectfully requests rejoinder and comment on these withdrawn claims.

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### CONCLUSIONS

The foregoing amendments and remarks are being made to place the Application in condition for allowance. Applicant respectfully requests the timely allowance of the claims 5, 6, 12, 13, 15, 16, 21, 23-28 and 35 and rejoinder (and subsequent allowance) of claims 29-34 because, in view of these amendments and remarks, Applicant respectfully submits that the rejections of claims 5, 6, 12, 13, 15, 16, 21, 23-28 (and 35) under 35 U.S.C. § 112 are herein overcome. Early notice to this effect is solicited.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned.

This paper is being filed timely within the three-month time period for response. No extensions of time are required. In the event any extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

Entry of the remarks made herein is respectfully requested.

Respectfully submitted,

MILLENNIUM PHARMACEUTICALS, INC.

By

  
Tracy M. Sioussat, Ph.D.  
Registration No. 50,609  
40 Landsdowne Street  
Cambridge, MA 02139  
Telephone - 617-374-7679  
Facsimile - 617-551-8820

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